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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,867	01/24/2001	Vittorio Castelli	XXT-055A (D/99368)	3156

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LAHIVE & COCKFIELD  
28 STATE STREET  
BOSTON, MA 02109

EXAMINER

COLILLA, DANIEL JAMES

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 03/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/768,867

Applicant(s)

CASTELLI ET AL.

Examiner

Dan Colilla

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2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8 and 13, drawn to a paper guide, classified in class 271, subclass 226.
  - II. Claims 9-12, drawn to a paper support, classified in class 269, subclass 55.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a paper support in a scanner. Invention II can be used. See MPEP § 806.05(d).

2. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with David Ridders on 3/13/02 a provisional election was made without traverse to prosecute the invention of group I, claims 1-8 and 13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### *Specification*

5. The disclosure is objected to because of the following informalities:

On page 3, lines 20-21, applicant states that the biasing member 600 may be a pinch spring or a leaf spring. It is not clear what the difference between these types of springs is. In applicant's drawings it appears that only one type of spring is represented.

Appropriate correction is required.

#### *Claim Objections*

6. Claim 13 is objected to because of the following informalities: it appears that applicant has intended the preamble of claim 13 to be a method for *preventing* deleting a trailing edge in order to be consistent with the disclosure.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-8 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kiyohara.

With respect to claims 1, 5, and 13, Kiyohara discloses the claimed apparatus and method including a paper guide 3, a biasing member 52. Figure 5 of Kiyohara shows the paper 47 being fed between the guide 3 and the spring 52 as the spring 52 presses the paper 47 against the guide 3.

With respect to claims 2 and 6, guide 3 is a roller mounted perpendicular to the paper path and can rotate on an axis 2.

With respect to claims 3 and 7, spring 52 appears to be structurally identical to the spring shown in applicant's Figure 1. Therefore, it appears that Kiyohara discloses a pinch spring.

With respect to claims 4 and 8, spring 52 has a second end shown in Figure 5 of Kiyohara and must have another end supported by the image forming system at some point since the spring cannot float by itself. The spring is shown aligned with the path of paper 47 in Figure 5 of Kiyohara.

With respect to claim 13, all the positively recited method steps are carried out by the structure mentioned in the above prior art rejection of claims 1 and 5. Kiyohara further discloses locating a printing device 48 proximate the biasing member 52 as shown in Figure 5 of Kiyohara.

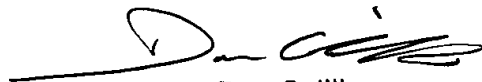
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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Matsui et al., Ten Broeck et al. and Niikura are cited to show other image forming systems with springs pressed against sheet guides.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (703) 308-2259. The examiner can normally be reached M-F, 8:30-5:30. Faxes regarding this application can be sent to (703) 746-4405.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (703)305-6619. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

March 14, 2002



Dan Colilla  
Primary Examiner  
Art Unit 2854